

REMARKS

The list of inventors has been changed to correct a typographical error. The first inventor's name has been corrected from "Nam-Kcun Kim" to "Nam-Keun Kim". Pursuant to M.P.E.P. 605.04(b), a new Declaration is not needed.

Claims 1-16 are pending in the application. The Examiner has required restriction of the pending claims under 35 U.S.C. § 121 to one of the following groups:

- I. Claims 1-11, drawn to a method of detecting a mutation; and;
- II. Claims 12-16, drawn to oligonucleotide primers for detection of a mutation.

The Examiner contends that the inventions of Groups I and II are distinct, each from the other.

Applicants hereby provisionally elect, with traverse, to prosecute the invention of Group I, claims 1-11.

Applicants submit that the claims of Groups I and II should be examined together. Restriction is not proper where the inventions are not independent, that is, where there is a disclosed relationship between them. Manual of Patent Examining Procedure (M.P.E.P.) 806. The disclosed relationship between the claimed method and the claimed primers is that the primers have the structure required to accomplish the method, that is, the primers comprise two primer binding sites and a restriction endonuclease restriction site.

The Examiner restricts the claims of Group I and Group II because "the polynucleotide products of group 2 can be used to encode polypeptides, which are not required to practice the methods of group 1." Office action, at page 4. However, M.P.E.P. 806.05(h) allows such restriction only where "the product *as claimed* can be used in a materially different process of using that product." Currently-pending claim 12, the sole independent primer claim, reads as follows:

12. *A primer for analyzing a gene mutation comprising a first primer binding sequence, a restriction enzyme recognition sequence, and a second primer binding sequence, wherein a polynucleotide fragment that is amplified using said primer, and is cleaved by two or more restriction endonucleases that recognize said restriction enzyme recognition sequence, comprises a mutation sequence, and wherein the size of said fragment is from 2 to 32 nucleotides in length.*

The primers of claims 12-16 are claimed as primers, particularly primers that are essential to the method of claims 1-11. They are not claimed as general nucleic acid sequences from which proteins may be expressed. As such, restriction between the primers, as claimed, and the methods of using them, is not appropriate. Moreover, because the


claimed primers are constructed to accomplish the claimed method, a search for, *e.g.*, art disclosing primers having the same structure, would necessarily identify art relating to the method of using those primers. Applicants therefore respectfully request that the election requirement be withdrawn, and that the Examiner examine all claims together.

The Examiner has further required a species election of a first restriction endonuclease and a second restriction endonuclease in claims 6 and 7. Applicants provisionally elect *Fok* I as the first restriction endonuclease and *Bst* F5 I as the second restriction endonuclease. Elected claims readable on these species are claims 1-11. Applicants reserve the right to have claims drawn to the remaining species examined when a generic claim is allowed.


Applicants respectfully request that the present remarks be made of record in the file history of the present application. An early allowance of the application is earnestly requested. The Examiner is invited to contact the undersigned with any questions concerning the application.

Respectfully submitted,

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